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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,542	03/20/2001	Maximilian Angel	51280	9058

26474 7390 06/04/2003

KEIL & WEINKAUF
1350 CONNECTICUT AVENUE, N.W.
WASHINGTON, DC 20036

EXAMINER

JOYNES, ROBERT M

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 06/04/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/811,542	ANGEL ET AL.	
	Examiner	Art Unit	
	Robert M. Joynes	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 10-13, 15-21 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) 6-9, 14 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 10-13, 15-21 and 23-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Receipt is acknowledged of applicants' Amendment and Response filed on March 10, 2003.

Double Patenting

Claims 1-5, 10-13, 15-21 and 23-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16, 18-24 and 27-30 of copending Application No. 09/805239. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim a capsule composition. The difference being only that one is deemed a soft capsule and the other deemed a hard capsule. No other distinction is seen between the claims. The same polymers and additional components are used in the same concentration ranges. Therefore, the claims are not patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments with respect to claims 1-5, 10-13, 15-21 and 23-25 have been considered but are moot in view of the new ground(s) of rejection.

The Examiner would like to indicate that he has also read the reply to the copending Application No. 09/805239. In that response, applicants attempt to distinguish between hard capsules and soft capsules. While the distinction is understood, it is the position of the Examiner that the distinctions are not reflected in the

claims. Hard capsules may be two-piece capsules and soft capsules may be one-piece capsules but the applicant has not shown that this is always true. Further, the reference provided by the applicant further distinguishes between hard and soft capsule wherein soft capsules further contain a plasticizer to provided flexibility while hard capsules are prepared without such a plasticizer. Therefore, the Examiner would like to make some suggestions that would place the claims in condition for allowances.

First, it is suggested that the hard capsule be further defined as a two-piece hard capsule.

Second, it is suggested that the limitations of the polyether-containing compounds be incorporated into Claim 1. Upon review of the Specification, it appears that the limitations of the polyether compounds are specific to certain polyethers and it does not appear that applicant is enabled for all polyethers. Therefore, inclusion of the specific polyether compounds is suggested, as is seen in Claim 2.

Finally, it is suggested that the same course of amendments take place in the copending Application No. 09/805239. It is further suggested that the soft capsule be defined as an one-piece soft capsule.

Conclusion

Due to the new grounds for rejection, this action is deemed non-final.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Joyner whose telephone number is (703)

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308-8869. The examiner can normally be reached on Mon.-Thurs. 8:30 - 6:00, alternate Fri. 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (703) 308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3592 for regular communications and (703) 305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Robert M. Joynes
Patent Examiner
Art Unit 1615
May 30, 2003

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600